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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,175	09/29/2000	Orna Etzion	42390.P7512	1540

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EXAMINER

MEONSKE, TONIA L

ART UNIT

PAPER NUMBER

2183

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/676,175

Applicant(s)

ETZION, ORNA

Examiner

Tonia L. Meonske

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-11 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-11 and 13-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/21/05</u> . | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement filed on March 21, 2005 has been considered. However it is unclear whether Applicant would like US Patent Application 09/458,121 officially considered. According to MPEP 609, each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date. Since the application is only identified by the application number and the file date, with the inventor omitted, the application has not been considered by Examiner.

### *Oath/Declaration*

2. It appears that the Declaration filed on June 15, 2005 under 37 CFR 1.131 is ineffective to overcome the Rozas et al. reference, US Patent 6,725,361.

According to MPEP 715.07(c):

#### **715.07(c) Acts Relied Upon Must Have Been Carried Out in This Country or a NAFTA or WTO Member Country**

35 U.S.C. 104. Invention Made Abroad.

(a) *IN GENERAL.* —

(1) **PROCEEDINGS.** —In proceedings in the Patent and Trademark Office, in the courts, and before any other competent authority, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country other than a NAFTA country or a WTO member country, except as provided in sections 119 and 365 of this title.

(2) **RIGHTS.** —If an invention was made by a person, civil or military —

(A) while domiciled in the United States, and serving in any other country in connection with operations by or on behalf of the United States,

(B) while domiciled in a NAFTA country and serving in another country in connection with operations by or on behalf of that NAFTA country, or

(C) while domiciled in a WTO member country and serving in another country in connection with operations by or on behalf of that WTO member country, that person shall be entitled to the same rights of priority in the United States with respect to such invention as if such invention had been made in the United States, that NAFTA country, or that WTO member country, as the case may be.

(3) **USE OF INFORMATION.** —To the extent that any information in a NAFTA country or a WTO member country concerning knowledge, use, or other activity relevant to proving or disproving a date of invention has not been made available for use in a proceeding in the Patent and Trademark Office, a court, or any other competent authority to the same extent as such

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information could be made available in the United States, the Director, court, or such other authority shall draw appropriate inferences, or take other action permitted by statute, rule, or regulation, in favor of the party that requested the information in the proceeding.

(b) **DEFINITIONS.** —*As used in this section* —

(1) The term “NAFTA country” has the meaning given that term in section 2(4) of the North American Free Trade Agreement Implementation Act; and

(2) The term “WTO member country” has the meaning given that term in section 2(10) of the Uruguay Round Agreements Act. The 37 CFR 1.131 affidavit or declaration must contain an allegation that the acts relied upon to establish the date prior to the reference or activity were carried out in this country or in a NAFTA country or WTO member country. See 35 U.S.C. 104. Under 37 CFR 1.131(a), which provides for the establishment of a date of completion of the invention in a NAFTA or WTO member country, as well as in the United States, an applicant can establish a date of completion in a NAFTA member country on or after December 8, 1993, the effective date of section 331 of Public Law 103-182, the North American Free Trade Agreement Act, and can establish a date of completion in a WTO member country other than a NAFTA member country on or after January 1, 1996, the effective date of section 531 of Public Law 103-465, the Uruguay Round Agreements Act. Acts occurring prior to the effective dates of NAFTA or URAA may be relied upon to show completion of the invention; however, a date of completion of the invention may not be established under 37 CFR 1.131 before December 8, 1993 in a NAFTA country or before January 1, 1996 in a WTO country other than a NAFTA country.

3. The declaration does not contain an allegation that the acts relied upon were carried out in this country or in a WTO member country. A declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

4. According to **MPEP 715.07 I.GENERAL REQUIREMENTS:**

37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. In *Ex parte Donovan*, 1890 C.D. 109, 52 O.G. 309 (Comm'r Pat. 1890) the court stated

If the applicant made sketches he should so state, and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made the witness should state as nearly as possible the language used in imparting knowledge of the invention to others.

However, when reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and “notes.” An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a

general assertion that the exhibits describe a reduction to practice “amounts essentially to mere pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit “asserts that facts exist but does not tell what they are or when they occurred.”).

5. The declaration fails to give a clear explanation of the exhibits pointing out exactly what facts are established and relied upon by Applicant. The declaration alleges that the features of “translating a first block of instructions ... with a stack of data entry positions” is shown in the top five blocks of the figure with the transformation of ‘Code Block L1’ to ‘Code Block L2’, that the feature of “generating an expected TOS position in said stack for said block of code” is shown in the top five blocks of the figure by the entry condition ‘Expected TOS’, and that the feature of “adding at least one ... translated first block of instructions” is shown in the top five block of the figure in the translated pseudo-code sections of ‘Code Block L1’ and ‘Code Block L2’. These allegations do not specifically point out and clearly explain the facts relied upon to show completion of the invention prior to June 16, 2000. The declaration vaguely refers to the top five blocks in Exhibit A. The Nexus between the claimed invention and the evidence submitted is not clear and as such Applicant has failed to prove an actual reduction to practice. Even so, Examiner has reviewed the Declaration in its entirety and believes that the submitted evidence, if clearly explained, still fails to show the claim limitation “adding at least one translated first block of instructions to determine if said first expected TOS is equal to an actual TOS at a time of executing said translated first block of instructions”. It appears that Applicant may be attempting to rely on the compare instruction in the second block (Cmp 5, Actual\_TOS), however, the compare instruction, at best, merely illustrates the actual TOS is compared to 5, not to the expected TOS. Coincidentally 5 happens to be the value of the expected TOS, however, not enough evidence has been submitted to prove that 5 was specifically substituted to represent a comparison of the actual TOS to the expected TOS.

6. According to **MPEP 2138.05:**

**TESTING REQUIRED TO ESTABLISH AN ACTUAL REDUCTION TO PRACTICE:**

"The nature of testing which is required to establish a reduction to practice depends on the particular facts of each case, especially the nature of the invention." Gellert v. Wanberg, 495 F.2d 779, 783, 181 USPQ 648, 652 (CCPA 1974) ("an invention may be tested sufficiently ... where less than all of the conditions of actual use are duplicated by the tests"); Wells v. Fremont, 177 USPQ 22, 24-5 (Bd. Pat. Inter. 1972) ("even where tests are conducted under bench' or laboratory conditions, those conditions must fully duplicate each and every condition of actual use' or if they do not, then the evidence must establish a relationship between the subject matter, the test condition and the intended functional setting of the invention," but it is not required that all the conditions of all actual uses be duplicated, such as rain, snow, mud, dust and submersion in water).

7. The declaration and supporting evidence do not show that sufficient testing has been performed to verify that the invention works for its intended purpose. Examiner is unable to locate a working example and/or accompanying test data with inputs and outputs to prove that the invention actually works. The invention must be shown to work for its intended purpose.
8. For the above noted reasons, the declaration filed on June 15, 2005, under 37 CFR 1.131, is ineffective to overcome the Rozas et al. reference, US Patent 6,725,361.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 3-6, 8-11, and 13-15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Rozas et al., US Patent 6,725,361.

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11. The rejections are respectfully maintained and incorporated by reference as set forth in the office action mailed on June 1, 2004.

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

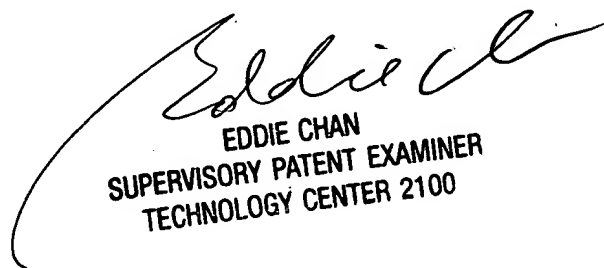
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tonia L. Meonske whose telephone number is (571) 272-4170. The examiner can normally be reached on Monday-Friday, with every other Friday off.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie P. Chan can be reached on (571) 272-4162. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TLM

  
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